

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Aya JAKOBOVITS et al.

Application No.: 09/771,312

Confirmation No.: 7650

Filed: January 26, 2001

Art Unit: 1642

For: 84P2A9: A PROSTATE AND TESTIS
SPECIFIC PROTEIN HIGHLY EXPRESSED IN
PROSTATE CANCER

Examiner: B. Fetterolf

APPLICATION FOR PATENT TERM ADJUSTMENT UNDER 37 CFR 1.705

MS Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Madam:

On behalf of the applicants, the undersigned requests reconsideration of the patent term adjustment indicated in the Notice of Allowance. This application for patent term adjustment is filed within two months of patent issuance and is, therefore, timely. The fee required under 37 CFR 1.705(b)(1) as set forth in 37 CFR 1.18(e) is enclosed with the present application.

Correct Patent Term Adjustment

Applicants again respectfully request an additional credit of 511 days be added to the 801 days of adjustment as indicated on the Issue Notification. The additional credit, minus applicants' delay, results in a revised total of 1,312 days of patent term adjustment.

Statement of Facts

The Office, in the Decision on Application for Patent Term Adjustment, mailed February 24, 2009 (herein, “Decision”), made a preliminary determination of 619 days of patent term adjustment. This preliminary determination was subject to revision based on the actual issue date. Subsequently, with the Issue Notification, the Office made a determination of 801 days of patent term adjustment. Applicants traverse the subsequent determination of 801 days and reconsideration is respectfully requested.

Calculation of patent term adjustment requires the applicant to get credit for “A delay” days and “B delay” days, provided that the days do not overlap. *Wyeth v. Dudas*, 580 F.Supp.2d 138 (D.D.C. 2008). An “A delay” day overlaps with a “B delay” day only if the “A delay” day is on the same calendar date as a “B delay” day. *Id.* The “B delay” period begins on the date three years after the filing date. *Id.* In this case, the “B delay” period begins on January 26, 2004, which is three years after the filing date of January 26, 2001. The following analysis shows that applicants are entitled to 1,312 days of patent term adjustment, which includes 671 administrative “A delay” days, plus 1,011 administrative “B delay” days, minus 370 of applicants’ delay days.

Applying *Wyeth v. Dudas*, there are 671 administrative “A delay” days. The relevant period of overlap in this case concerns the 813 day delay credited to the applicants, since the end date of June 16, 2004 includes both “A delay” days and “B delay” days. *See* page 6 of the Decision. The period of overlap includes the 142 days from January 26, 2004 through June 16, 2004, since these dates are both “A delay” and “B delay” days. In conclusion, subtracting 142 days from 813 days yields 671 administrative “A delay” days.

Applicants respectfully disagree with the Office’s Exclusion Interpretation of 35 USC 154(b)(2)(A) and the Office’s application of 37 CFR 1.703(f) Actual Delay Limitation. This interpretation is inconsistent with *Wyeth v. Dudas*. Under the incorrect Exclusion Interpretation, the Office would conclude that the 813 days of adjustment for failure to issue an action constitute “overlap” with the “B delay” period.

Applicants calculate the administrative “B delay” days as follows. Based on the issue date of March 31, 2009, the Office has failed to issue a patent within 3 years from the date on which the present application was filed (January 26, 2001). Based on this projected issue date, applicants are entitled to an additional credit of 1,011 days in accordance with 35 USC 154(b)(1)(B) and 37 CFR 1.702(b), 1.703(b).

The following are the 370 days due to the applicants’ delay.

Applicants filed a response on May 28, 2002 to a notice to file missing parts, mailed January 10, 2002. The Office correctly calculates 48 days of applicants’ delay in accordance with 35 USC 154(b)(2)(C)(ii) and 37 CFR 1.704(b).

Applicants filed a response on March 24, 2005 to a restriction requirement, mailed December 15, 2004. The Office correctly calculates 9 days of applicants’ delay in accordance with 35 USC 154(b)(2)(C)(ii) and 37 CFR 1.704(b).

Applicants filed a response on October 13, 2005 to a non-final office action, mailed May 4, 2005. The Office correctly calculates 70 days of applicants’ delay in accordance with 35 USC 154(b)(2)(C)(ii) and 37 CFR 1.704(b).

Applicants filed a request for continued examination on November 3, 2006 in response to a final rejection, mailed June 28, 2006. The Office correctly calculates 36 days of applicants’ delay in accordance with 35 USC 154(b)(2)(C)(ii) and 37 CFR 1.704(b).

Applicants filed a notice of appeal on August 7, 2007 in response to a final rejection, mailed February 12, 2007. The Office correctly calculates 87 days of applicants’ delay in accordance with 35 USC 154(b)(2)(C)(ii) and 37 CFR 1.704(b).

Applicants filed a corrected Appeal Brief on June 18, 2008 in response to a notice that the Appeal Brief is Non-Compliant. The Office correctly calculates 103 days of applicants’ delay in accordance with 35 USC 154(b)(2)(C)(ii) and 37 CFR 1.704(b).

Applicants filed a Supplemental Information Disclosure Statement on November 10, 2008. The Office has not calculated a delay based on the Supplemental Information Disclosure Statement, however, applicants calculate 17 days of applicants' delay in accordance with 37 CFR 1.704(c)(10).

Applicants calculate a total PTO delay of 1,682 days minus applicants' delay of 370 days, for a revised total of 1,312 days of additional patent term. Based on the foregoing information, applicants respectfully request reconsideration of the patent term adjustment.

Conclusion

In the event the U.S. Patent and Trademark Office determines that an extension and/or other relief is required, Applicants petition for any required relief including extensions of time and authorizes the Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to Deposit Account No. 03-1952 referencing docket no.

511582000100.

Dated: May 29, 2009

Respectfully submitted,

Electronic signature: /Daniel A. Rubé/
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